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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,309	09/16/1999	JAMES L. BAUER	2854.72	8591

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/397,309

Applicant(s)

BAUER ET AL.

Examiner

Clement B Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

DETAILED ACTION

1. Applicant's arguments files on 3/11/03 have been fully considered but they are moot in view of new grounds of rejections.
2. Claims 1-87 are remained.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or unobviousness.
5. Claim 1-86, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (Hereinafter Walker US Patent No.5, 945, 653) in view of Hoffman et al (Hereinafter Hoffman U.S Patent 6, 397, 198).

As per claims 1, 5-22, and 40-87, Walker discloses providing a debit card("i.e. credit card see column 1 line 15") to the user, wherein the debit card is associated with a financial account such that the user may use the debit card to make purchases(See column 1 lines 15-25), and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account defining periods of time.(See column 8 lines 30-45 and column 1 lines 20-40), providing a report ("i.e. billing statements") to the user at the end of each defined period identifying, at least in

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part, the purchases made with the debit card during the defined period. (See column 21 lines 20-40 and column 7 lines 40-50) designating a retailer as a preferred retailer.(See column 3 line 65 and column 4 line 5) interpretive as credit card users belonging to a selected issuer using a selected retailer and calculating a reward amount for the user based at least in part, on purchases made using the debit card during a current period (See column 3 lines 45-50 and column 19 lines 10-35).

Walker fails to teach, crediting the reward amount generated during the current period to a user reward account; activating the user reward amount at the end of the current period debiting the amount of the cost of a purchase in a subsequent period from the financial account, and crediting the financial account an amount up to the amount of the purchase in the subsequent period from the activated user reward account for purchases made at the preferred retailer.

However Hoffman discloses a rewards account is defined as an account that contains reward-units deposited by a rewards transaction processor entity, the rewards account is optionally managed by the rewards transaction processor entity, or by a third party such as an individual, a retail service provider, a retail product provider, that manages rewards accounts from various reward-units issuers, a rewards transaction is any electronic debiting or crediting of reward-units ("i. e, amount") with respect to a recipient's or a user's rewards account.(See column 4 line 30) during initial registration of a user, a magnetic stripe reader is used to read the account information that is encoded on the magnetic stripe of the user's credit or debit card to expedite linking a user's credit/debit account or rewards account number to a registration biometric

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sample identity of the user and to reduce errors associated with entry of financial data and account numbers.(See column 5 line 40) and the users must also register the appropriate electronic account information, such as a checking, a rewards, or a credit card account, for crediting and debiting of their electronic accounts.(See column 8 line 5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Walker modify to include the crediting of reward amount generated during the current period to a user reward account, activating the user reward amount at the end of the current period debiting the amount of the cost of a purchase in a subsequent period from the financial account, and crediting the financial account an amount up to the amount of the purchase in the subsequent period from the activated user reward account for purchases made at the preferred retailer that is taught by Hoffman in order to provide an audio signature associated with the transaction processor to notify and authenticate to the user the identity of the party that has processed the user's transaction, while not requiring the user to present any personalized man-made memory tokens such as smart cards, magnetic swipe cards, encoded paper checks or personal computers for identification.

As per claims 2-3, Walker and Hoffman fails to teach a debit card is issued by a financial institution or first financial institution and wherein the financial account is held by a second financial institution or financial institution. However a debit card is issued by a financial institution or first financial institution and wherein the financial account is held by a second financial institution or financial institution is old and well known in the art because it is common

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for some financial institutions hold financial accounts while others have others financial institutions holding those accounts. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to included a debit card is issued by a financial institution or first financial institution and wherein the financial account is held by a second financial institution or financial institution in order for some financial institutions hold financial accounts while others have others financial institutions holding those accounts.

As per claim 4, Walker discloses storing user reward amounts for periods prior to the current period. (see column 23 lines 55-65).

As per claim 23, and 25-39, Walker discloses providing a debit card("i.e. credit card see column 1 line 15") to the user, wherein the debit card is associated with a financial account such that the user may use the debit card to make purchases(See column 1 lines 15-25), and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account defining periods of time.(See column 8 lines 30-45 and column 1 lines 20-40), providing a report ("i.e. billing statements") to the user at the end of each defined period identifying, at least in part, the purchases made with the debit card during the defined period. (See column 21 lines 20-40 and column 7 lines 40-50) designating a retailer as a preferred retailer.(See column 3 line 65 and column 4 line 5) interpretive as credit card users belonging to a selected issuer using a selected retailer and calculating a reward amount for the user based at least in part, on purchases made using the debit card during a current period (See column 3 lines 45-50 and column 19 lines 10-35).

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Walker fails to teach, crediting the reward amount generated during the current period to a user reward account; activating the user reward amount at the end of the current period debiting the amount of the cost of a purchase in a subsequent period from the financial account, and crediting the financial account an amount up to the amount of the purchase in the subsequent period from the activated user reward account for purchases made at the preferred retailer.

However Hoffman discloses a rewards account is defined as an account that contains reward-units deposited by a rewards transaction processor entity, the rewards account is optionally managed by the rewards transaction processor entity, or by a third party such as an individual, a retail service provider, a retail product provider, that manages rewards accounts from various reward-units issuers, a rewards transaction is any electronic debiting or crediting of reward-units ("i. e, amount") with respect to a recipient's or a user's rewards account.(See column 4 line 30) during initial registration of a user, a magnetic stripe reader is used to read the account information that is encoded on the magnetic stripe of the user's credit or debit card to expedite linking a user's credit/debit account or rewards account number to a registration biometric sample identity of the user and to reduce errors associated with entry of financial data and account numbers.(See column 5 line 40) and the users must also register the appropriate electronic account information, such as a checking, a rewards, or a credit card account, for crediting and debiting of their electronic accounts.(See column 8 line 5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Walker modify to include the crediting of reward amount generated during the current period to a user reward account, activating the user reward amount at the end of the current period debiting the amount of the cost of a purchase in a subsequent period from the financial account, and crediting the financial account an amount up to the amount of the purchase in the subsequent period from the activated user reward account for purchases made at the preferred retailer that is taught by Hoffman in order to provide an audio signature associated with the transaction processor to notify and authenticate to the user the identity of the party that has processed the user's transaction, while not requiring the user to present any personalized man-made memory tokens such as smart cards, magnetic swipe cards, encoded paper checks or personal computers for identification.

As per claim 24, Walker discloses the debit card is issued by the financial institution and wherein the financial account is administered by the financial institution.(see column 3 line 65 and column 4 line 5 and column 6 lines 15-25).

#### Conclusion

#### Response to Arguments

6. Applicant's arguments files on 3/11/03 have been fully considered but they are moot in view of new grounds of rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

August 11, 2003

*Bella Lunde*  
FSA